

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s): Lonka et al.

SERIAL NO.: 09/268,080

ART UNIT: 2681

FILING DATE: 3/12/99

EXAMINER: N. Muang

TITLE: TELESCOPIC TELEPHONE

ATTORNEY

DOCKET NO.: 297-008554-US (PAR)

Commissioner of Patents
Washington, D.C. 20231

TRANSMITTAL OF SUPPLEMENTARY APPEAL BRIEF

Sir:

This is in response to the Office Action mailed March 29, 2002 and the resulting reopening of prosecution as per Paragraph 1 of the Official Action. Appellants hereby request reinstatement of the appeal.

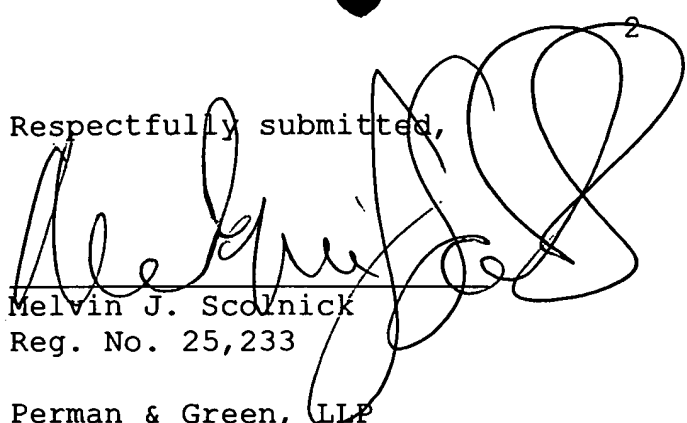
In view of Appellants' election of reinstatement of the appeal, enclosed is a Supplemental Appeal Brief in accordance with the requirements of MPEP 1208.02. It is respectfully requested that the enclosed Supplementary Appeal Brief be considered along with the originally filed Appeal Brief, and that the fee paid for the originally filed Appeal Brief cover the cost of the Supplementary Appeal Brief.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

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SUPPLEMENTARY APPEAL BRIEF

Sir:

This is an appeal in regard to the rejection of claims 2-7, 13 and 15-19 in the above-identified patent application in accordance with MPEP 1208.02. Claims 8-12 were found allowable but objected to as being dependent upon a rejected base claim. Claims 2-7, 13 and 15-19 are listed in Appendix I. Claims 8-12 are listed in Appendix II. A Notice of Appeal was mailed to the USPTO on November 26, 2001. An appeal brief was filed on the December 20, 2001. Prosecution of the application was reopened in a non-final Official Action mailed March 29, 2002. Appellant is filing this Supplementary Appeal Brief in accordance with the option granted to Appellant in MPEP 1208.02.

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It is respectfully submitted that there continues to be an error in the Office Action "Summary" mailed with the rejection of March 29, 2002. The "Summary" refers to claim 1 as still pending in the application. Claims 1 was cancelled in Applicants' first Amendment filed on March 30, 2001. Correction by the Examiner is requested.

I. Real Party In Interest

The real party in interest in this application is Nokia Mobile Phones Limited.

II. Related Appeals and Interferences

There are no directly related appeals or interferences regarding this Application.

III. Status of Claims

Claims 2-13 and 15-19 are pending in this Application. Pending claims 2-7, 13 and 15-19 were finally rejected by the Examiner in a final rejection dated June 18, 2001. Claims 8-12 were found allowable but objected to. Appellant filed an Appeal

Brief on January 8, 2002. The Examiner thereafter reopened prosecution, and Appellant in accordance with MPEP 1208.02 has elected the option of requesting reinstatement of the appeal. Attached to this Brief is Appendix I (the rejected claims 2-7, 13 and 15-19) and Appendix II (the allowable claims 8-12). The rejection of claims 2-7, 13 is being appealed.

IV. Status of the Amendments

Since the final rejection of June 18, 2001 and the Amendment of September 17, 2001, an Appeal Brief was filed on December 20, 2001. In response to the Appeal Brief, the Examiner reopened prosecution in an Official Action dated March 29, 2002.

V. Summary of the Invention

The present invention relates to the structure of a telescopically expanding telephone, and to the location of various elements on the telephone. The object of the present invention is to introduce a telephone which is small in the transport position, but is still provided with a larger-size user interface. Another object of the present invention is to have a telephone that is easy to use, durable and ergonomic. Still another object of the present invention is that in the

regular usage position, the telephone antenna is prevented from falling in the shadow of the user's hand. These and other objectives of the present invention are achieved by locating, in the upper part of the telephone, an antenna and the radio frequency parts, among others; and in the lower part, the power source and the major part of the keys, among others. The lower part and the upper part are movably attached to each other, so that the telephone has a small-size transport position and a larger-size operating position. Thus there is a critical element with regard to the overall structure of the telephone and the location of various elements on the phone.

The telephone according to the clearly defined claimed features of the present invention comprises a first part and a second part attached thereto, the second part being movable in relation to the first part between a first position and a second position. The invention is characterized in that the first part comprises a radio transmitter/receiver and a connected antenna, and the second part comprise an arrangement for fastening a battery to the second part.

According to a preferred embodiment of the present invention, the upper part of the telephone comprises at least an antenna, a radio transmitter/receiver, a loudspeaker, a microphone and a

display as well as part of the keys and a scanner for a smart card. The lower part comprises an arrangement for fastening a battery of a corresponding power source for the telephone, as well as the major part of the keys. The lower part of the telephone is designed in such a manner so that during various operations, it is natural for the user to hold the lower part of the telephone in the user's hand. Thus, the antenna provided in the upper part is not left in the shadow of the user's hand, and not even in close proximity to the user's hand. The battery attached to the lower part is a fairly heavy component, which improves the ergonomic properties of the telephone according to the invention in comparison with, for example, the telephone according to Figure 3, where the lower part is very light. By installing the telephone components in the upper and the lower parts in an advantageous fashion the number of electric contacts in between the parts is kept small, which is advantageous for usage security. In particular, the features of the present invention enables the use of a relatively large display and keyboard even in a small mobile phone.

VI. Issues

1. Are claims 3-5, 13 and 15-19 unpatentable under 35 U.S.C. 103(a) over Murray et al. (U.S. Patent No. 6,011,699) in view of Reber et al. (U.S. Patent No. 6,002,946)?

Is claim 2 unpatentable under 35 U.S.C. 103(a) over Murray et al. (U.S. Patent No. 6,011,699) and Reber et al. (U.S. Patent No. 6,002,946), and further in view of the Applicants' admitted prior art (Fig. 4)?

2. Are claims 6, 7 and 18 unpatentable under 35 U.S.C. 103(a) over Rudisill et al. (U.S. Patent No. 6,208,874) in view of Murray et al. (U.S. Patent No. 6,011,699)?

VII. Grouping of Claims

The claims do not stand or fall together. There are two (2) groups of claims. The groups are as follows:

Group 1-Claims 2-5, 13 and 15-19;

Group 2-Claims 6, 7 and 18.

In accordance with 37 C.F.R. 1.192(c)(7), an explanation of why the claims of the groups are believed to be separately patentable is contained in the argument section below.

VIII. Argument

A. Claims 2, 2-5, 13 and 15-19

Claim 18 calls for a telephone comprising:

- (1) a first part;
- (2) a second part attached to the first part movable between a first position and a second position;
- (3) a radio transceiver in the first part and an antenna coupled thereto;
- (4) and in the second part, a keyboard for providing control input information to the radio transceiver, and
- (5) an arrangement for attaching a battery to the second part parallel to the keyboard and additionally comprising in the second part a grip design for allowing a user to hold the telephone by the second part.

Primary objects of the combined features of the present invention include introducing a telephone which is small in the transport position, but is still provided with a large-size user interface. Also, an object is introducing a telephone that is, with respect to its mechanical structure, easy to use, durable and ergonomic. Yet another object of the present invention is that in the regular usage position, the telephone antenna does not fall in the shadow of the user's hand. The combination of all of these objects is what motivated appellant to develop the invention described in this application. These objects are achieved by locating, in the upper part of the telephone, an antenna and the radio frequency parts, among others, and in the lower part of the telephone, the power source and the major part of the keys, among others, all in a specific arrangement. The lower part and the upper part are movably attached to each other, so that the telephone has a small-size transport position and a larger-size operating position. The various objectives were achieved by the critical placement of various parts in a mobile telephone. The position of the various parts of a mobile telephone in accordance with the claimed invention is what has allowed appellant to achieve the objectives stated above, and the various advantages resulting from these objectives.

It is respectfully submitted that what is required to determine patentability is a very honest assessment of what is actually in fact taught by the prior art. The real fact of the matter is that the prior art teaches and suggests very generally that various parts of a mobile telephone may be placed at various locations of the telephone. However, a general teaching that you may put anything anywhere does not anticipate a specific, detailed solution where very specific and very advantageous properties are achieved for the mobile telephone by placing the certain recited parts just in a specific way and not in any other way. The bottom line is that a general teaching is legally not sufficient to support a legal conclusion of obviousness under 35 U.S.C. 103(a).

A careful examination of the Murray et al. patent reveals to one skilled in the art that what it actually discloses is a mobile phone which was developed with a specific housing, and housing hinge structure to more evenly distribute the operational circuitry between multiple housing elements. As compared to the presently claimed invention, (i.e. the combination of claimed features as described above in claim 18) one skilled in the art would be taught by Murray et al. about a collapsible telephone consisting of an upper part and a lower part, of which the lower part enclosed all functional parts of the telephone except the

display and the loudspeaker. A basic disadvantage of such a solution is related to the location of the radio transceiver and its antenna in the lower part. It is relatively easy to conceive how the user's hand would shadow and load the antenna regardless of the way in which the user prefers to grasp the telephone. If the user grips the lower part, the antenna ends up behind the user's fingers or extreme part of the palm, so that the electromagnetic load to the antenna is usually made worse by extremely conductive noble metal rings on the user's fingers. If the user prefers to grip the upper part of the telephone, the antenna is again shadowed, this time by the proximal part of the palm or the wrist, where the metal strip of a wristwatch or a bracelet possibly comes into the near field of the antenna.

Appellants' claims define a battery that is attached "parallel" to the keyboard. Appellant does not debate the fact that a mobile telephone is known to include a battery, but it is respectfully submitted that appellant claims a structure where the battery has a specific location with respect to certain other parts of a mobile telephone, i.e. the specific location of the battery is significant and forms part of Appellants' claimed invention. This cannot be ignored as the Examiner has chosen to do. Such a specific structure is neither disclosed nor suggested

by the drawings or the specification of Murray et al. or Reber et al. It is respectively pointed out that the claims of this application which define the invention specifically refer to "... an arrangement for attaching a battery to the second part..." of the telephone "... parallel to the keyboard..."

Webster's Seventh New Collegiate Dictionary defines the word "parallel" as

"extending in the same direction everywhere equidistant and not meeting... everywhere equally distant..."

The Examiner has stated that the mobile phone of Murray et al. shows:

"an arrangement for attaching battery to the second part parallel to the keyboard (Fig. 7, items 722, 76; col. 5, line 45 to col. 6, line 44)" (Emphasis added)

Appellant has read col. 5, lines 4-5 to col. 6, line 44 of Murray et al. several times and cannot find any disclosure that states that the battery is "parallel" to the keyboard. Maybe a little hindsight obtained from Appellants' specification is the reason why the Examiner believes that Murray et al. teaches that

the battery is disclosed as being "parallel" to the keyboard. So when the Examiner states "The combination of Murray and Reber teaches "all" of the claimed limitations as disclosed in claim 18", there is a very questionable issue that exists as to whether this is true or not. The Examiner has very simply failed to provide sufficient evidence to support the rejection of claim 18.

It is respectfully submitted that the Examiner who is one skilled in the art, also noticed that the Murray et al. patent falls very short of anticipating Appellants' claimed invention. The Examiner has cited the Reber et al. patent as a way for making up for this lack of disclosure. However, by following the path of this combination of references one collides into the "you may put anything anywhere" teaching and its lack of anticipation regarding any specific placing of the parts. At the lower part of col. 7 of the Reber et al. patent, there is generally mentioned how the radio transceiver, processor, speech synthesizer and battery can be placed in whichever parts of the telephone. This general statement does not anticipate any specific solution nor does it anticipate any specific solution with specific advantages. A specific solution is recited in Appellants' independent claims, with the specific advantages of

easy handling, advantageous weight distribution, and shadow-free operation for the radio transceiver and its antenna.

It is respectfully submitted that the Examiner's rejection is completely without legal merit because it is based on a rejection under 35 U.S.C. 103(a) where whenever the prior art references fail to disclose or suggest a feature specifically claimed by Appellant, the Examiner concludes that what is not disclosed would be "obvious". Following that kind of philosophy then the U.S. Patent and Trademark Office could close its doors and cease operation.

From the entire record what is "obvious" is that the only real basis for the Examiner's combination of the Murray et al. and Reber et al. patents is Appellants' own disclosure, i.e., the hindsight obtained from this application. The simple fact of the matter is that by no stretch of the imagination can it be correctly legally concluded that Appellants' invention as defined in claims 2-5, 13 and 15-19 is obvious under 35 U.S.C. 103(a) from the combined teaching of the disclosures of the Murray et al. and Reber et al. patents.

It is very clear that, only as a result of the hindsight obtained from Applicant's own disclosure could the Examiner have

concluded that it would have been obvious to one of ordinary skill in the art to combine the Murray et al. and Reber et al. patents with or without Appellants' admitted prior art and conclude that such combination render Appellants' claimed invention legally "obvious". The Examiner has simply not cited evidence to substantiate that Appellants' invention is obvious.

The legal standards for a correct rejection under 35 U.S.C. 103(a) are well settled in the law. To reject claims in an application under section 103, an Examiner must show an un rebutted prima facie case of obviousness. It is the Examiner who must provide the lack of patentability. See In re Deuel, 51 F. 3d 1552, 1557, 34 USPW2d 1210, 1214, (Fed. Cir. 1995). In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See In re Oetiker, 1977 F. 2d 1443, 1445, 24 USPW2d 1443, 1444 (Fed. Cir. 1992).

Obviousness is a question of law. Pandiut Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987) cert. Denied, 481 U.S. 1052 (1987). The courts have held that the proper approach to the obviousness issue starts with the claimed invention as a whole. Kimberly-Clark Corp. v. Johnson & Johnson, 745 F.2d 1437, 1448 (Fed. Cir. 1984). The invention as a whole embraces

the structure, its properties and the problem it solves. In re Wright, 848 F.2d 1216, 1219 (Fed. Cir. 1988). Section 103 is applicable when there is no single prior art item that completely discloses, i.e., anticipates, the claimed invention. Kalman v. Kimberly-Clark, 713 F.2d 760 (Fed. Cir. 1983).

The proper approach to making a determination of obviousness was described by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 17 (1966); Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. It is respectfully submitted that the Examiner has simply not met the proper legal requirements for a valid rejection under 35 U.S.C. 103(a) and has failed to meet the proper burden of proof.

As the CAFC has stated in In re Rouffet, 47 USPQ2d 1453 (CAFC, 1998) at pages 1457 and 1458:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with

no knowledge of the claimed invention, would select the elements from the cited prior art references... (Emphasis added)

Neither Murray et al. nor Reber et al. were confronted with the same problems as Appellant. Appellant was concerned with resolving issues directly and specifically related to the location of the various elements on mobile phones. Murray et al. was specifically concerned with the need to more evenly distribute the operational circuitry between multiple housing elements of a mobile phone. Quite apart from all of these objectives and motivating factors is the motivations involved in the Reber et al. patent, i.e. the need for an added device such as a two-way communication apparatus to include an optical data reader in the housing of the device.

The CAFC has many times during the last year affirmed the strict requirements for a valid rejection under 35 U.S.C. 103(a).

In Ecolochem Inc. v. Southern California Edison Co., 5 USPQ2d 1065 (CAFC, 2000) it was stated at page 1065:

Although the suggestion to combine prior art references to achieve the invention claimed in the patent may be found in inexplicit or in implicit teachings in the references themselves; from ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved, there must be evidence that the skilled artisan, confronted with the same problems as inventor and with no knowledge of the claimed invention, would select elements from the cited prior art references for combination in the manner claimed; an implicit, generalized finding that a person of ordinary skill in the art faced with same problem as inventor, would have found the claimed combination obvious is insufficient (Emphasis added).

In addition, it is not realistic in deciding an obviousness question under 35 U.S.C. 103 to pick and choose from any one reference only so much of the reference as will support a given position, to the exclusion of the other parts necessary to a full appreciation of what such reference fairly suggests to one of ordinary skill in the art; the mere existence in the prior art of individual elements of a patented invention does not, without more, invalidate a patent under 35 U.S.C. 103; there must be some positive evidence that the bringing together of such elements would have been obvious to a person of ordinary skill in the art; it would reduce patent protection almost to a nullity if an infringer could, in the light of a subsequent disclosure, combine various prior art references and piece together portions of earlier patents, while dropping other parts, and thereby invalidate new combination of old elements. Colt Industries Operating Corp. v. Index-Werke KG, Han & Tessky (DC DistCol.) 205 USPQ 990. (Emphasis added).

Furthermore, as stated in In re Lee 61 USPQ2d 1430 @ page 1433:

[1] As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See e.g., McGinley v. Franklin Sports, Inc. 262 F.3d 1339, 1351-52 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPW2d, 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obviousness holding") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPW2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPW2d 1614, 1617 (Fed. Cir. 1999).

Claim 2 is dependent of claim 18 and includes the limitations:

additionally comprising in the first part a display and a quick-action keyboard, and in the second part a number keyboard.

For the same reasons as stated above with regard to claim 18, the combination of Murray et al. and Reber et al. with or without the combination of the prior art (Appellants' Fig. 4) fail to disclose or suggest the combined limitations of the above additional features in combination with the other features of claim 18. Therefore, the Examiner's rejection of claim 2 based upon the combination of Murray et al. Reber et al. and Appellants' admitted prior art should be reversed.

Claim 3 is dependent on claim 18 and includes the limitations additionally comprising in the second part a module which comprises:

a circuit board of the number keyboard;

a charging connector to form a connection to an external charging device arranged to charge a battery attached to the second part, and

a connector to form an electric connection between the first and the second part.

For the same reasons as stated above with regard to claim 18, the combination of Murray et al. and Reber et al. fail to disclose or even remotely suggest the unique features of claim 3. The combination of Murray et al. and Reber et al. fail to disclose or suggest the combined limitations of the above additional features of a module in the second part of the telephone in combination with the other features of claim 18. Therefore, the Examiner's rejection of claim 3 based upon the combination of Murray et al. and Reber et al. should be reversed.

Claim 4 is dependent on claim and includes the further limitation:

"wherein said connector for forming the electric connection between the first and the second part is simultaneously a connector for creating an electric connection between the second part and a battery attached thereto."

For the same reason as stated above with regard to claims 18 and 3, the combination of Murray et al. and Reber et al. fail to disclose or even remotely suggest the unique features of claim 4. The combination of Murray et al. and Reber et al. fail to disclose or suggest the combined limitations of the above additional features of a connector for forming the electric connection between the first and second part module in the second part of the telephone in combination with the other features of claims 18 and 3. Therefore, the Examiner's rejection of claim 4 based upon the combination of Murray et al. and Reber et al. should be reversed.

Claim 5 is dependent upon claim 3, which in turn is then dependent upon claim 18, and includes the further limitation:

"... additionally comprising in said module a vibrating alarm device attached to the circuit board of the number keyboard."

All of the above comments with regard to claims 18 and 3 are herein again repeated, but with regard specifically to claim 5. In addition, it is submitted that while the Examiner is correct that the Murray patent discloses a vibrating alarm device (129), the Examiner is wrong (legally) in the conclusion that the teaching or suggestion of the combined references renders Appellants' invention defined by claim 5 as "obvious". It is respectfully submitted that this is just another example of the Examiner finding a claimed element in a reference and simply "gluing" parts of the references together with other references, and erroneously concluding that the claimed invention is "obvious". Therefore, the Examiner's rejection of claim 5 based upon the combination of Murray et al. and Reber et al. should be reversed.

Claim 13 is dependent on claim 18 and includes the further limitation:

"... wherein the second part is rotatably movable with
— respect to—the first part in between the first and the second position for which function the telephone is provided with a hinge in between the first and the second part."

For the same reasons as stated above with regard to claim 18, the combination of Murray et al. and Reber et al. fail to disclose or even remotely suggest the unique features of claim

13. The combination of Murray et al. and Reber et al. fail to disclose or suggest the combined limitations of the above additional features of the second part being rotatably movable in combination with the other features of claim 18. Therefore, the Examiner's rejection of claim 13 based upon the combination of Murray et al. and Reber et al. should be reversed.

Claim 15 is dependent on claim 18 and includes the further limitation

"... additionally comprising a protecting shell of the first part, wherein said antenna is a plane antenna located inside said protecting shell of the first part."

For the same reasons as stated above with regard to claim 18 the combination of Murray et al. and Reber et al. fail to disclose or even remotely suggest the unique features of claim 15. The combination of Murray et al. and Reber et al. fail to disclose or suggest the claimed limitations of the above additional features of the protecting shell in combination with the other features of claim 18. Therefore, the Examiner's rejection of claim 15 based upon the combination of Murray et al. and Reber et al. should be reversed.

Claim 16 is dependent on claim 18 and includes the further limitation:

"additionally comprising means for receiving an incoming call by adjusting said first part from the first position to the second position."

For the same reasons as stated above with regard to claim 18, the combination of Murray et al. and Reber et al. fail to disclose or even remotely suggest the unique features of claim

16. The combination of Murray et al. and Reber et al. fail to disclose or suggest the combined limitations of the above additional features of a means for receiving an incoming call in combination with the other features of claim 16. Therefore, the Examiner's rejection of claim 16 based upon the combination of Murray et al. and Reber et al. should be reversed.

Claim 17 is dependent on claim 18 and includes the further limitation that the phone:

"... is a mobile phone of a digital-cellular network."

For the same reasons as stated above with regard to claim 18, the combination of Murray et al. and Reber et al. fail to disclose or even remotely suggest the unique features of claim 17. The combination of Murray et al. and Reber et al. fail to disclose or suggest the combined limitations of the above additional features of a telephone in the form of a mobile phone of a digital cellular network in combination with the other features of claim 17. Therefore, the Examiner's rejection of claim 17 based upon the combination of Murray et al. and Reber et al. should be reversed.

"... wherein said grip by the user is at the area of the lower part of the telephone."

For the same reasons as stated above with regard to claim 18, the combination of Murray et al. and Reber et al. fail to disclose or even remotely suggest the unique features of claim 19. The combination of Murray et al. and Reber et al. fail to disclose or suggest the combined limitations of the above additional features of a grip for the telephone in combination with the other features of claim 19. Therefore, the Examiner's

rejection of claim 19 based upon the combination of Murray et al. and Reber et al. should be reversed.

B. Claims 6, 7 and 18

Note that claim 18 has also been included in the same group with claims 6 and 7. All of these claims have been rejected over Rudisill et al. (U.S. Patent No. 6,208,874) in view of Murray et al. (U.S. Patent No. 6,011,699).

Claim 18 (an independent claim) states:

"A telephone comprising a first part; a second part; a second part attached to the first part movable between a first position and a second position; a radio transceiver in the first part and an antenna coupled thereto; and in the second part, a keyboard for providing control input information to the radio transceiver, and an arrangement for attaching a battery to the second part parallel to the keyboard and additionally comprising in the second part a grip design for allowing a user to hold the telephone by the second part."

Claim 6 is dependent upon claim 18 and includes the further limitation:

"wherein the second part is slidably movable in relation to the first part in between the first and the second position, for which function the second part comprises slide rails and the first part comprises matching counter-rails."

Claim 7 is dependent on claim 6 and includes the further limitation:

"wherein said first part and second part are in the first position located essentially on top of each other."

In supporting the rejection of claims 6, 7 and 18 as being unpatentable over Rudisill et al. in view of Murray et al. the Examiner has stated:

"Consider claim 18. Rudisill teaches a telephone comprising a first part (Fig. 1, item 52), a second part (fig. 1, item 48) attached to the first part movable between a first position and a second position (i.e. slide open and close, fig. 1); an antenna coupled to the first part (fig. 4, items 90, 92 and 94).

In the second part, a keyboard for providing control input information to the radio transceiver (fig. 1, item 30), and additionally having in the second part a grip design for allowing a user to hold the telephone by the second part (fig. 1, item 48).

An arrangement for attaching a battery to the phone is inherently in Rudisill. However, Rudisill does not explicitly show the arrangement of attaching the battery to the second part parallel to the keyboard.

Nevertheless, the claimed limitation is a matter of design preference, and it is very well-known in the art as evidenced by Murray.

Murray teaches an arrangement for attaching a battery to a second part parallel to the keyboard (fig. 7, items 720, 706; col. 5). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a battery in order to power the telephone.

Consider claim 6. Rudisill further teaches the second part is slidably movable in relation to the first part in between the first and the second position, for which function the second part comprises slide rails and the first part has matching counter-rails (fig. 1, items 72, 64, and 24).

Consider claim 7. Rudisill further teaches the first and the second part are in the first position located essentially on top of each other (fig. 3)."

The Rudisill et al. patent teaches about a telephone with a first housing and a second housing slidably secured to the first housing for movement between an open position and a closed position, the second housing projecting out from the first housing in the open position. The telephone also includes an antenna pivotably attached to the second housing. A position control mechanism is provided to pivot the antenna away from the second housing, and a guide is provided to secure the antenna against pivoting when the second housing is in the closed position. It is respectfully submitted that by employing the same logical reasoning as set forth by appellant above with regard to the rejection of claim 18 under 35 U.S.C. 103(a) over Murray et al. in view of Reber et al., only one conclusion is possible, i.e., claims 18, 6 and 7 are clearly patentable and not obvious in view of the combined teaching of Rudisill et al. in view of Murray et al. There is no other correct legal conclusion. It must be remembered that Appellants' invention as defined in claims 18, 6 and 7 is for a telephone where very specific and advantageous properties are achieved for the mobile telephone by placing the parts (i.e. the parts specifically recited in the claims) in a very specific and critical way, and not in any general way. It is by this specific and critical placement of parts in a mobile phone that the specific advantages are achieved. It is very simple as the Examiner has apparently done to read Appellants' application and from the hindsight obtained therefrom conclude that everything is "obvious" and a matter of "design" preference.

As stated above a careful examination of the Murray et al. patent reveals that it discloses a mobile phone which was developed with a specific housing and housing hinge structure to more evenly distribute the operational circuitry between

multiple housing elements. As compared to the presently claimed invention, i.e. the combination of claimed features as described above in claim 18, one skilled in the art would be taught by Murray et al. about a collapsible telephone consisting of an upper part and a lower part, of which the lower part enclosed all functional parts of a telephone except the display and the loudspeaker. A basic disadvantage of such a solution is related to the location of the radio transceiver and its antenna in the lower part. It is easy to conceive how the user's hand would shadow and load the antenna regardless of the way in which the user prefers to grasp the telephone. If the user grips the lower part, the antenna ends up behind the user's fingers or extreme part of the palm, so that the electromagnetic load to the antenna is usually made worse by extremely conductive noble metal rings on the user's fingers. If the user prefers to grip the upper part of the telephone, the antenna is again shadowed, this time by the proximal part of the palm or the wrist, where the metal strap of a wristwatch or a bracelet possibly comes into the near field of the antenna.

It is once again respectfully submitted that the Examiner has not submitted sufficient or proper evidence to support a legally correct rejection of the claims under 35 U.S.C. 103(a). The rejection of a patent application for obviousness under 35 U.S.C. §103 must be based on evidence comprehended by language of the section and the search for and analysis of prior art includes evidence relevant to a finding of whether there is a teaching, motivation or suggestion to select and combine references relied on as evidence of obviousness; the factual inquiry whether to combine references must be thorough and searching based on objective evidence of record, and the Board of Patent Appeals and Interferences must explain reasons why one

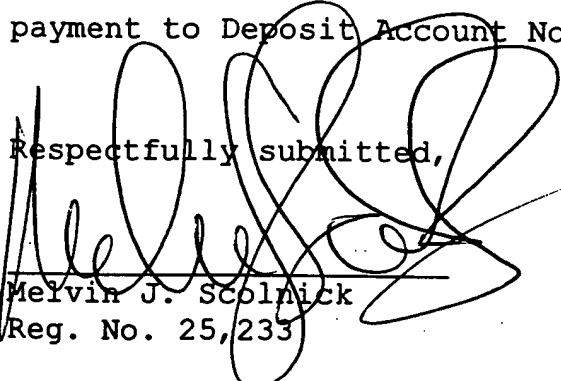
of ordinary skill in art would have been motivated to select references and to combine them to render claimed invention obvious. In re Lee, 61 USPQ 2d 1430 (CAFC 2002). In re Lee requires that not only must the Examiner have the burden of proving the lack of patentability, but the Examiner must prove such lack of patentability with sufficient and correct evidence.

IX. Conclusion

In view of the arguments presented above, it is respectfully requested that the Examiner's rejections of claims 2-7, 13 and 15-19 be reversed.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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6/25/02
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APPENDIX IREJECTED CLAIMS

2. A telephone according to claim 18, additionally comprising in the first part a display and a quick-action keyboard, and in the second part a number keyboard.

3. A telephone according to claim 18, additionally comprising in the second part a module which comprises

a circuit board of the number keyboard,

a charging connector to form a connection to an external charging device arranged to charge a battery attached to the second part, and

a connector to form an electric connection between the first and second part.

4. A telephone according to claim 3, wherein said connector for forming the electric connection between the first and second part is simultaneously a connector for creating an electric connection between the second part and a battery attached thereto.

5. A telephone according to claim 3, additionally comprising in said module a vibrating alarm device attached to the circuit board of the number keyboard.

6. A telephone according to claim 18, wherein the second part is slidably movable in relation to the first part in between the first and the second position, for which function the second part comprises slide rails and the first part comprises matching counter-rails.

7. A telephone according to claim 6, wherein said first part and second part are in the first position located essentially on top of each other.

13. A telephone according to claim 18, wherein the second part is rotatably movable with respect to the first part in between the first and the second position, for which function the telephone is provided with a hinge in between the first and the second part.

15. A telephone according to claim 18, additionally comprising a protecting shell of the first part, wherein said antenna is a plane antenna located inside said protecting shell of the first part.

16. A telephone according to claim 18, additionally comprising means for receiving an incoming call by adjusting said first part from the first position to the second position.

17. A telephone according to claim 18, characterised in that it is a mobile phone of a digital cellular network.

18. A telephone comprising a first part; a second part attached to the first part movable between a first position and a second position; a radio transceiver in the first part and an antenna coupled thereto; and in the second part, a keyboard for

providing control input information to the radio transceiver, and an arrangement for attaching a battery to the second part parallel to the keyboard and additionally comprising in the second part a grip design for allowing a user to hold the telephone by the second part.

19. A telephone in accordance with the features of claim 18 wherein said grip by the user is at the area of the lower part of the telephone.

APPENDIX II
ALLOWABLE CLAIMS

8. A telephone according to claim 6, additionally comprising an elastic member for creating a spring force in between the first and the second part.

9. A telephone according to claim 8, wherein said elastic member is a spring having an excited position and a released position, so that the first position of the second part corresponds to the excited position of the spring, and the second position of the second part corresponds to the released position of the spring.

10. A telephone according to claim 9, additionally comprising a trigger mechanism in order to lock the second part in the position where said spring is excited, and to release the locked second part by means of user action.

11. A telephone according to claim 10, additionally comprising a mechanical attenuator for attenuating the mutual motion between the first and second part while the second part moves in relation to the first part under the influence of the force created by said spring.

12. A telephone according to claim 11, wherein said attenuator comprises a gear wheel and a gear rack arranged in functional interaction with it, said gear wheel and gear rack being located one in the first part of the telephone and the other in the second part thereof, as well as an attenuating member for attenuating the rotating motion of said gear wheel.